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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,074	02/02/2004	Jennifer Hay	M93.12-0296	9839

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EXAMINER

LE, TOAN M

ART UNIT PAPER NUMBER

2863

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/770,074	Applicant(s) HAY, JENNIFER	
	Examiner Toan M. Le	Art Unit 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-38,40-46,48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-38,40-46,48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 5-38, 40-46, and 48-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The method claims do not produce a tangible result. It is unclear how the result is being stored, displayed, or used in any tangible manner. In order to overcome the rejection, claim language should be added that includes displaying, storing or conveying used in tangible manner. To view the new guidelines for 35 U.S.C. 101 please view the following OG notice.

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by “Instrumented Indentation Testing”, Hay et al. (referred hereafter hay et al.).

Referring to claims 20-22, Hay et al. disclose a computer readable medium including instructions readable by a computer, which when implemented, cause the computer to detect an initial point of engagement between an indenter or tensile tester and a test sample from data measurements comprising the steps of:

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receiving a data series indicative of test measurements as a function of a first variable;
generating at least one processed series from the data series (page 232, 3rd col. to page 233, 1st and 2nd col.; page 236, Measurement of Creep Parameters section: 1st col.);
identifying a first point on the at least one processed series;
identifying a second point on the at least one processed series (figures 4 and 9);
calculating the initial point of engagement as a function of the first point, the second point, and the speed of the indenter or tensile tester relative to the sample; and further comprising receiving the data series as a function of at least one other variable and wherein the test measurements indicate force (page 233, 2nd and 3rd col.; page 236, Measurement of Creep Parameters section).

As to claim 23, Hay et al. disclose a computer readable medium including instructions readable by a computer, which when implemented, cause the computer to detect a point of engagement between an indenter or tensile test system and a test sample comprising the steps of:

receiving a data series indicative of test measurements as a function of a first variable;
generating at least one processed series from the data series (page 232, 3rd col. to page 233, 1st and 2nd col.; page 236, Measurement of Creep Parameters section: 1st col.);
identifying a first point on the at least one processed series;
identifying a second point on the at least one processed series (figures 4 and 9);
calculating the point of engagement as a function of at least one of the first point and the second point (figures 4 and 9);
receiving the data series as a function of at least one other variables, wherein the test measurements indicate force, and wherein the first variable comprises displacement and the at

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least one other variable comprises time (page 233, 2nd and 3rd col.; page 235, Time-Dependent materials and Properties section to page 236, Measurement of Creep Parameters section).

Referring to claim 24, Hay et al. disclose a computer readable medium including instructions readable by a computer, which when implemented, cause the computer to detect an initial point of engagement between an indenter or tensile tester and a test sample from data measurements comprising the steps of:

receiving a data series indicative of test measurements as a function of a first variable;
generating at least one processed series from the data series (page 232, 3rd col. to page 233, 1st and 2nd col.; page 236, Measurement of Creep Parameters section: 1st col.);
identifying a first point on the at least one processed series;
identifying a second point on the at least one processed series (figures 4 and 9);
calculating the initial point of engagement as a function of both the first point and the second point (figures 4 and 9); and

receiving the data series as a function of at least one other variable, wherein generating at least one processed series comprises calculating speed of the indenter or tensile tester relative to the test sample to generate a first processed series (page 233, 2nd and 3rd col.; page 235, Time-Dependent materials and Properties section to page 236, Measurement of Creep Parameters section).

Response to Arguments

Applicant's arguments with respect to claims 1-2, 5-38, 40-46, and 48-49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan M. Le whose telephone number is (571) 272-2276. The examiner can normally be reached on Monday through Friday from 9:00 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Toan Le

August 18, 2006

BRYAN BUI
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'B. Bui', with a long horizontal flourish extending to the right.